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The time period for reply, if any, is set in the attached communication.

RECORD OF ORAL HEARING  
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex Parte* OLLE CARLBARK, KENNETH STRANNEMALM,  
and EWA KOLBY FALK

Appeal 2009-003804  
Application 09/529,638  
Technology Center 3700

Oral Hearing Held: October 7, 2009

Before DONALD E. ADAMS, LORA M. GREEN, and JEFFREY N. FREDMAN, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANTS:

WILLIAM ROWLAND, ESQUIRE  
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The above-entitled matter came on for hearing Wednesday, October 7, 2009, commencing at 10:16 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Deborah Courville, a Notary Public.

PROCEEDINGS

THE USHER: Calendar Number 14, Appeal Number 2009-3804,  
Mr. Rowland.

JUDGE ADAMS: Thank you. Good morning, Mr. Rowland.

MR. ROWLAND: Good morning.

JUDGE ADAMS: We're familiar with your issues. You'll have 20  
minutes. If you could begin by spelling your name for the record, and you  
can begin when you're ready.

MR. ROWLAND: Spell my name, is that what you said?

JUDGE ADAMS: Please.

MR. ROWLAND: R-o-w-l-a-n-d.

Thank you for this opportunity. Today's invention is not technically  
complex, but it's in my opinion quite clever, and I don't want that to be  
overlooked. It's a garment that comprises an absorbent part in two separate  
waist belts, and one end of each of the two separate belts is permanently  
fastened, directly or indirectly, to the absorbent part and other ends are  
fastened together. The belts have a stiffening material that forms a stiffness  
that varies in the cross-section -- the cross-direction of the belts, wherein the  
stiffness that varies has an extension in the longitudinal direction.

The advantage is that the structure can provide regions of higher  
stiffness that are useful for avoiding unwanted deformation, while at the  
same time enabling other regions with less stiff areas, for example, at the  
edge, which might be much more comfortable to the user. So it provides a  
combination of fitting nicely and still being comfortable.

The Examiner has applied two references. The first one is H1440.

1 The reference is called New, and New describes a fitted belt for an absorbent  
2 garment, and an important factor here is that the belt in New is generally  
3 arcuate in shape. And the focus of New is to provide a better-fitting belt that  
4 discretely conforms to the contours of the wearer and is less noticeable  
5 under clothing. Therefore, the waist bands in the New disclosure  
6 conspicuously lack an additional material that could increase the thickness  
7 of the waistband, such as elastic elements.

8 The Examiner recognized that New did not have the stiffening  
9 material that varies in the cross-direction of the belts and she has applied  
10 Herrin as a secondary reference. Herrin is directed to a disposable  
11 undergarment waistband that attaches and detaches to a disposable garment  
12 panel, and the belts in Herrin don't attach to each other, but are used to  
13 connect two different portions of the undergarment panel.

14 JUDGE GREEN: Is that why -- it's my understanding during  
15 prosecution Herrin was actually applied as a 102(b). Is that the reason why  
16 that was not -- was dropped? Is that your understanding of the prosecution  
17 history?

18 MR. ROWLAND: That's one question I hadn't prepared for. I don't  
19 remember the history. I don't remember why -- this took place back in 2004,  
20 2005.

21 JUDGE GREEN: Okay.

22 MR. ROWLAND: I should have read through that, but I didn't.  
23 Anyway, the Examiner alleges that it would --

24 JUDGE GREEN: Well, I guess, the question becomes if this has the  
25 two belts that connect to each other, would this be more of anticipatory art?

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1           MR. ROWLAND: No, it would not have been anticipatory, because I  
2 believe that our claim says that the two belts are permanently fastened,  
3 directly or indirectly, to the absorbent part. And if I recall, in Herrin  
4 they're -- it's detachable at both sides of the belts.

5           JUDGE GREEN: Okay. But the belt itself has the stiffness that  
6 ranges across this transverse direction?

7           MR. ROWLAND: The belt itself has a stiffness that ranges across  
8 direction, but there's more to the invention than just that one --

9           JUDGE GREEN: No, I understand that.

10          MR. ROWLAND: -- feature, of course. So the Examiner alleges it  
11 would have been obvious to modify New with the belts of Herrin to provide  
12 good stretch and recovery characteristics and easy attachment. As far as the  
13 easy attachment is concerned, I don't think that's really any sufficient  
14 motivation. For one thing, as we just discussed, the belts in the claim are  
15 permanently attached to the absorbent article. As far as the other end of the  
16 belts where they attach to each other, both references use the Velcro or hook  
17 and loop type material. So there's no reason that you would go look to one  
18 to modify the other.

19          JUDGE FREDMAN: But, I mean, we're not now constrained that  
20 there has to be, you know, motivation to substitute. I mean, essentially,  
21 KSR told us that, you know, if the parts are equivalent that there may be -- it  
22 may be obvious none-the-less to, you know, replace one part with another in  
23 an equivalent situation.

24          MR. ROWLAND: You're right that KSR does say that, but the -- I  
25 think the important part is it may be. KSR also says that -- rather than  
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1 misquote it, I'll just read it. KSR also requires that there must be some  
2 articulated reasoning with some rational underpinning to support the legal  
3 conclusion of obviousness. And I interpret that as requiring more than just  
4 being able to go into the prior art with the claims as a shopping list and pull  
5 together two things and fit them together. There's got to be some reason --

6 JUDGE FREDMAN: Agree with that.

7 MR. ROWLAND: -- for doing it. I'm sorry?

8 JUDGE FREDMAN: Yes.

9 MR. ROWLAND: Okay.

10 JUDGE ADAMS: Now, in order to reach your claim, do we need to  
11 modify New's belt with some permutation from Herrin's belt, or can we just  
12 take Herrin's belt, sew the ends to the back of the absorbent article and use  
13 the free ends to wrap around the rest of the article? And would that reach  
14 your claim limitations?

15 MR. ROWLAND: Herrin's belt is a little different in that if you look  
16 at Figures 1 and 2, Herrin's belt is really two -- requires two separate belt  
17 pieces, neither of which are connected to each other, and they are two  
18 interconnected --

19 JUDGE ADAMS: Well, New teaches that you can take these belts  
20 and sew them to each other at the back of the absorbent article, right?

21 MR. ROWLAND: Yes.

22 JUDGE ADAMS: Okay. So keep going.

23 MR. ROWLAND: But if you were going to sew one of the Herrin  
24 belts to the absorbent article, which I guess is your question, it still would  
25 not result in an arrangement where you have two belts where the ends are  
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1 fastened to each other. Because the Herrin belts are just -- essentially,  
2 they're side panels that connect the front end to the rear end of the absorbent  
3 panel. Whereas, in our invention, these belts are connected to, typically, the  
4 rear portion of the panel and they come around and the belt ends are  
5 connected to each other, which is something that Herrin doesn't --

6 JUDGE ADAMS: But isn't that what's taught by New? I mean, so  
7 what are we really modifying here? We're just taking Herrin's belt and  
8 making it attach like New's does, is that correct?

9 MR. ROWLAND: You mean what is the Examiner doing?

10 JUDGE ADAMS: Yes. Because he just says it's obvious to modify  
11 the garment of New with the waist belts of Herrin, right? So he's saying take  
12 Herrin's belts and apply them the way that New did on his absorbent panel.

13 MR. ROWLAND: Well, maybe I can answer that by following up on  
14 our discussion with KSR. Why would you do that? The Examiner --

15 JUDGE ADAMS: Because New says you can.

16 MR. ROWLAND: New says you can take the belts of Herrin?

17 JUDGE ADAMS: New says you can attach belts in this manner.

18 Herrin teaches belts. I mean, both Herrin and New are talking about  
19 absorbent garments with belts, right? Is it that far from a person of ordinary  
20 skill in the art to know that there's different ways you can attach belts  
21 together?

22 MR. ROWLAND: I don't think it's a question of the way the belts are  
23 attached. I think what's more important is why would somebody who's  
24 looking at the New reference, why would they have any motivation to go to  
25 Herrin and use the Herrin belt? The Examiner talks about -- what did she

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1 say, stretch and recovery characteristics, but New already addresses that. In  
2 the Figure 9 embodiment, New teaches that if you want to add some stretch  
3 and recovery characteristics to it, you embed these triangular pieces of  
4 elastic material.

5 JUDGE GREEN: Well, when would an ordinary artisan understand  
6 these are equivalent, they perform the same kind of function? I guess that's  
7 what we're trying to get at. I mean, they're just different ways of doing the  
8 same thing.

9 MR. ROWLAND: Well --

10 JUDGE GREEN: I mean, if we're to follow that, well, New already  
11 found a way to do it and therefore nobody would modify it. You've knocked  
12 obviousness out of the ball park, don't even look at obviousness anymore.  
13 So, but given that that's not the standard, why wouldn't one of ordinary skill  
14 in the art understand that you could have used the belt and -- the elastic belt  
15 of Herrin and the garment of New, especially saying that Herrin teaches that  
16 this is a disposable undergarment waistband that provides a flexible, cost  
17 efficient, disposable solution to these kinds of problems?

18 MR. ROWLAND: Well, if you took the Herrin belt and tried to adapt  
19 it to the New disclosure, you would destroy the purpose of New. In other  
20 words, the whole -- the primary emphasis in New is to have this arcuate belt  
21 that conforms to the wearer's body and provides for discreteness and for  
22 more comfort. If you took --

23 JUDGE GREEN: But I don't think you're -- the purpose of New is  
24 really to have a way to attach an absorbent article or something for a wearer  
25 so they comfortably this absorbent undergarment. I think it's ordinary to  
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1 understand that there may be some tradeoffs. One may be a little bit more  
2 bulky than the other. But I think to say you're destroying the whole purpose  
3 of New is really kind of -- I mean, the undergarment is still going to work as  
4 a disposable undergarment and the belt's still going to hold the absorbent  
5 undergarment on the wearer.

6 MR. ROWLAND: Right. But the -- what New says repeatedly  
7 throughout each embodiment is they want an arcuate-shaped belt that's going  
8 to conform to the wearer's body. If you take the Herrin belt, because it has  
9 the elastics throughout the cross-direction, you won't be able to -- it won't  
10 conform into an arcuate shape. It'll be as any other traditional belt,  
11 essentially, rectangular, and it won't have the advantage that New is --

12 JUDGE FREDMAN: But in fact in Figure 9A of New, he shows a  
13 belt that looks awfully rectangular to me.

14 MR. ROWLAND: It does. But if you read it carefully, 9A is  
15 designed with these --

16 JUDGE FREDMAN: Elastic regions.

17 MR. ROWLAND: -- frusto conical elastics such that when you put it  
18 on it conforms into an arcuate shape. So when it's -- yeah, when it's lying  
19 unused on the table, it's going to be rectangular. But when you put it on, it  
20 goes into an arcuate shape.

21 JUDGE FREDMAN: But he still has a rectangular belt. It just -- in  
22 other words, if you take the belt of the Herrin reference and you put it into  
23 Figure 9A, you have a rectangular belt that has advantages of Herrin that  
24 might also have these additional features, these frusto conical elastics.

25 MR. ROWLAND: No. The Herrin belt would not conform to the  
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1   wearer's body. It would not bend in an arcuate shape, because the  
2   elastication's equal throughout the cross-direction of the belt. An important  
3   part of the Figure 9A belt in Herrin is that you have greater elasticity in one  
4   edge than in the other. So when you put it on, it becomes arcuate -- I can't  
5   remember the terms they use, but it conforms to the wearer's body.

6           JUDGE FREDMAN: Okay.

7           MR. ROWLAND: If you put the New belt on -- I mean, if you put the  
8   Herrin belt on New, you're not going to have any of the structure that New  
9   goes to so much trouble to teach that is his invention. So I have to disagree.  
10   I think to put the Herrin belt on New would completely destroy the purpose  
11   of New. Yeah, it would be a diaper, but that's not what New is. New is a  
12   diaper with an improved belt that is inconspicuous and comfortable.

13          JUDGE FREDMAN: New is actually a statutory invention  
14   registration, actually. It's not a patent, but --

15          MR. ROWLAND: Okay. I'm sorry, if I misspoke. But, yes.

16          JUDGE ADAMS: But you would agree or disagree that you can  
17   connect belts, whether they're capable of forming an arcuate shape or not, in  
18   the manner that New does?

19          MR. ROWLAND: Sure. You could put any kind of belt on New.  
20   But I believe the MPEP says very clearly that an obviousness rejection is  
21   improper if the combination destroys the purpose and function of the  
22   primary reference. And my position is --

23          JUDGE ADAMS: Hold a diaper onto a baby?

24          MR. ROWLAND: I'm sorry?

25          JUDGE ADAMS: The function and purpose of the belt is to put a --

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1 is to hold a diaper on an individual.

2 MR. ROWLAND: I think if you ask New what the function and  
3 purpose of his disclosure was, he would say to teach an inconspicuous and  
4 comfortable belt that also holds the diaper on.

5 JUDGE ADAMS: Okay. Anything else?

6 MR. ROWLAND: Let me just flip through my notes and see. I think  
7 we didn't really go in the order I intended, but we covered everything.

8 JUDGE ADAMS: Great. Any further questions?

9 JUDGE GREEN: No.

10 JUDGE ADAMS: Further questions?

11 I thank you for coming in.

12 MR. ROWLAND: Thank you.

13 (Whereupon, the proceedings, at 10:32 a.m., were concluded.)  
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